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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,341	12/12/2001	Yongcai Wang	82662HEC	6168

7590

12/31/2003

Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER
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SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/31/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/021,341

Applicant(s)

WANG ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003 and 06 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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1. Claims 1-4, 6-9, and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (EP 903,246) for reasons of record (as set forth in the prior rejection under 35 USC 102) and for reasons given below. In accordance with applicant's claim 1, both the ink-receiving layer and the base layer may have the same composition. Therefore, it is appropriate to equate them to two ink receptive layers. There is no claim language in the instant claims distinguishing these layers from each other.

Applicants' representative argues that the base layer is not an image-receiving layer, however, the term "base layer" does not have a well defined meaning in the art that would preclude the layer from being one capable of holding a dye image. The examiner was unable to find a definition or description of "base layer" in the specification. The ink receptive layers of the reference will hold both dye and fluid carrier of an ink, both layers include inorganic particles and each may include antioxidant particles as recited by the instant claims. Therefore, the lower ink receptive layer of the reference may include what applicant refers to as "stabilizer particles." Therefore, it would have been obvious to include the antioxidant (stabilizer) particles in both layers because it is suggested by the reference. Additionally, there is nothing in the claims to indicate that the base layer absorbs the fluid carrier and the ink-receiving layer holds the dye, each to the exclusion of the other. As stated above, both ink receptive layers of the reference will perform both of these functions.

Applicants argue the different compositions and thicknesses disclosed for the two coating layers in their specification. These limitations may be disclosed, but are not

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present in the claims. Therefore, they cannot render the claims patentable over the prior art. The examiner has studied applicants' examples, however, one of ordinary skill in the art would have expected less fading to occur when antioxidant is present in both the surface layer and the base layer. The examiner is uncertain about what is referred to as "P-2" at the very bottom of page 20. However, it would appear that there is no dye-fixative in the layer. Consequently, dye may move through the image-receiving layer into the base layer. Additionally, components, such as antioxidants that are not firmly fixed within a medium, tend to move or migrate between layers over time. Therefore, one of ordinary skill in the art would have found it obvious to include antioxidants and/or UV absorbers in both coating layers to prevent image fade.

Finally, applicants' specification states that UV absorbers may be used to prevent fade as well as antioxidants (page 17 of the specification), so that it is unlikely that "consisting essentially of" language would exclude the inclusion of UV absorbers were such language used in the claims. It is unclear how such inclusion would materially affect the basic and novel characteristic(s) of the claimed invention.

2. Claims 1, 16 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (EP 903246) as applied to claim 1 above, and further in view of Chu et al. (6,440,537) for reasons of record and for reasons given above.

3. Claims 1, 16 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. (EP 903246) as applied to claim 1 above, and further in view of Becker (US 2002/0071019) for reasons of record and for reasons given above.

4. It is noted that claim 16 appears to be a duplicate of claim 1.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4-16 of copending Application No. 10/017937. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are directed to and ink jet recording element and the claims of the copending application are directed to the conventional method of using this element. All of the limitations concerning the ink jet recording element are fully disclosed in the method of use claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

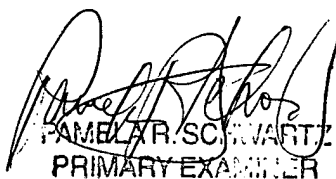
5. Applicant's arguments filed September 12, 2003 have been fully considered but they are not persuasive. The examiner wishes to thank applicants' representative for catching and correcting an obvious typographical error in the last office action that switched the grounds of rejection concerning claims 5 and 10.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose telephone number is 571-272-1528. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.

PRSchwartz  
December 27, 2003



PAMELA R. SCHWARTZ  
PRIMARY EXAMINER